

## REMARKS

1. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the amendments and discussion that follows. Claims 1-22 are pending in this application.

The specification has been objected to. Claims 1-16 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1-22 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 6,055,513 to Katz et al. After a careful review of the claims (as amended), it has been concluded that the rejections are in error and the rejections are therefore traversed.

2. Claims 1-16 have been rejected as being directed to non-statutory subject matter. In response, claim 1 has been further limited to a "programmed computer method". Support for the further limitation may be found at numerous locations throughout the specification (e.g.: the system 10 of FIG. 1 (specification, page 2); the CPU of the vendor (specification, page 4); the comparator 30 within the database 28 (specification, page 5); the "transaction processor 29 within the database 28" (specification, page 6); etc.)

Claim 1 has been further limited to "a third-party database forming data files at the request of the customer". This limitation is supported by the contributions of the customers that function to "form a portion of the information within the files" (specification, page 4). As would be clear to those of skill in the art, the contributions of preferences and

buying habits by customers to the database 28 would inherently result in the formation of files.

Claim 1 has been further limited to "a programmed computer of the database of third party searching the database". This limitation is supported by the fact that the comparator functions described within the specification (page 5) would inherently be performed by a programmed computer.

Claim 1 has been further limited to "a programmed processor forwarding promotional materials to the identified customers". This limitation is supported by the fact that the communication function for distributing promotional materials described in the specification (page 5) would inherently be performed by a programmed processor.

Claim 1 is now clearly defined in terms that are within the technological arts. Since claim 1 is now clearly limited to a practical application within the technological arts, the rejection under 35 U.S.C. §101 is now believed to be improper and should be withdrawn.

It is noted next that claim 9 has also been rejected as being drawn to non-statutory subject matter. In this regard, the Examiner asserts that "The specification does not conclusively state that the 'data entry device' consists of a 'keyboard and display'; the specification merely provides as an example of an item where the Examiner has a broad range of possible interpretation of data entry devices" and "the specification at p. 5, ll. 27-32, states that a mere example of distributing promotional materials is via 'e-mail'; the specification does not conclusively state that the promotional means consists of distribution by 'e-mail'" (Office Action of 12/30/04, page 11).

However, there is no requirement that the applicant

conclusively state that "the data entry device" consists of a "keyboard and display" or that the distribution of promotional material occurs via "e-mail". More to the point (with regard to the distribution of promotional materials) the specification explicitly states that "The customer 32, 34 may receive the promotional material by any appropriate medium (e.g., e-mail, direct mail, point of sale print-out, etc.)" (specification, page 8). In this regard, the only requirement is that the applicant provide examples of how the invention may be practiced. This the applicant has done.

Claim 9 is a means-plus-function claim under 35 U.S.C. §112, paragraph 6. In this regard "The plain and unambiguous meaning of paragraph 6 is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein . . . Paragraph six does not state or even suggest that the PTO is exempt from this mandate". In re Donaldson Co. Inc. 29 USPQ2d, 1848 (App.Ct. Fed. Ct. 1994). Further, the Examiner is "required by statute to look to . . . specification and construe the 'means' language recited in . . . claim 1 as limited to the corresponding structure disclosed in the specification and equivalents thereof". In re Donaldson Co. Inc. 29 USPQ2d, 1850 (App.Ct. Fed. Ct. 1994). Since the Examiner has clearly not done this, the rejection of claims 8-16 are believed to be improper and should be withdrawn.

3. Claims 1-22 have been rejected as being obvious over Katz et al. In response claim 1 has been further limited to "a third-party database forming data files at the

request of the customers. Support for this additional limitation has been discussed above.

It is noted first, that Katz et al. is merely directed to telemarketing and "Most particularly, . . . the selection and offering of an upsell transaction" (Katz et al., col. 1, lines 13-17).

In contrast, the claims are limited to "a programmed central processing unit of a vendor of independent vendors forming a customer profile for targeting delivery of the promotional materials to potential customers" and to "means for forming a customer profile by a vendor for targeting delivery of the promotional materials to potential customers". In each case, the claimed invention is limited to "a customer profile for targeting delivery of the promotional materials to potential customers". The fact that the claim is limited to the plural form of customer is no accident. More to the point, the claimed invention is clearly directed to more than one customer and to the case where the customer profile is formed in advance of any customer contact for which the profile will be used.

In contrast, Katz et al. is limited to forming a profile of only a single customer. The profile is formed only for a single telephone call and then used only to upsell to the one customer.

Further, even assuming arguendo that Katz et al. did forward promotional materials (which Katz et al. does not), Katz et al. is directed to a single vendor, whereas the claims are limited to a system used by a plurality of vendors.

With regard to the multiple vendors, the Examiner takes "Official Notice . . . that both the concepts and the advantages of 'a plurality of independent vendors . . . '

were notoriously well known and expected at the time of the invention" (Office Action of 12/30/04). However, the Examiner fails to provide any coherent explanation of why a plurality of vendors would use the teachings of Katz et al. In addition, even if they did, the result would still be that of a multitude of vendors all forming a profile of a single customer at the time of the call, only for the duration of the call and then only using the profile to upsell rather than to cross-sell.

In addition, without some recognition that Katz et al. could be used for cross-selling, there would be no reason to modify Katz et al. as suggested by the Examiner. Since there is no apparent way by which Katz et al. could be used for cross-selling, it is believed that there is no basis for Official Notice. Since there is no basis for Official Notice, it is respectfully requested that the Examiner provide a factual basis for multiple vendors doing cross-selling as required by MPEP §2144.03(C).

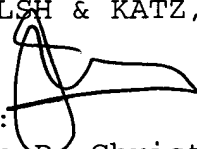
In addition, claim 1 is now limited to "a third-party database forming data files about customers at the request of the customers". Katz et al. clearly fails to provide any teaching or suggestion of a third-party database that forms files at the request of the customers.

For any of the above reasons, it is believed that Katz et al. fails to teach or suggest each and every claim limitation. Since Katz et al. fails to provide each and every claim limitation, the rejection is believed to be improper and should be withdrawn.

4. Allowance of claims 1-22, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

WELSH & KATZ, LTD.

By:   
Jon P. Christensen  
Registration No. 34,137

February 4, 2005  
WELSH & KATZ, LTD.  
120 S. Riverside Plaza  
22nd Floor  
Chicago, Illinois 60606  
312-655-1500